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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2672

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,414

Applicant(s)

DUTTA, RABINDRANATH

Examiner

Jeffery A Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-19 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-19 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/26/04 has been entered.

Response to Amendment

2. The amendment filed on 4/26/2004 has been entered. Claims 1-4,6-19 and 26-31 are pending. Claims 5 nad 20-25 have been cancelled.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 6-19, and 26-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 29-31:

Claim 4 is indefinite because at lines 3-4 a web page containing a link to the first image is claimed and at line 11 the client receives the web page which contained the link to the first image and the client receives the modified version of the first image from

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the ad server. This is indefinite because if the web page links to the first image then how does the client link to the modified version of the first image located in the ad server? Dependent claims 29-31 do not correct this problem.

Claims 1, 2 and 6-12:

Claim 1 is indefinite because at line 3 "the first image" is claimed while earlier only a first vector graphics image is claimed. Since the specification describes both bit map image and vector graphics image then the claimed should clearly claim which type of image applicant intends to be the subject of the invention. Therefore "the first image" at lines 3, 7 and 8 should be "the first vector graphics image". At line 7 "the second images" is indefinite for the same reason given for the first image. At lines 7 and 9 "the second image" should be "the second vector graphics image".

Dependent claims 2, 6, 7, 9, 10, and 11 have the same problems and should be amended according to the above suggestions.

Dependent claims 8 and 12 do not correct these problems.

Claims 3 and 26-28:

These claims have the same problem associated with "the first image" and "the second image". The above suggested corrections for claim 1 is suggested for these claims.

Claims 4 and 29-31:

These claims have the same problem associated with "the first image" and "the second image". The above suggested corrections for claim 1 is suggested for these claims.

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Claims 13-19:

These claims have the same problem associated with "the first image" and "the second image". The above suggested corrections for claim 1 is suggested for these claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 6, 8-15, and 26-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohn et al., U.S. Patent No. 6,317,780. Cohn teaches web pages having links to image, video and audio data, column 7 lines 6-13. Cohn also teaches using Macromedia Flash as the means to provide and display moving images, column 9 lines 55-60. Macromedia Flash is a scalable vector graphics language using ".swf" file format. Cohn teaches using a web page to link a scalable vector graphics file, Macromedia Flash, and overlaying a portion of the image formed by the web page with

an advertisement formed from scalable vector graphics, Macromedia Flash, column 9 lines 47-60 and column 11 lines 16-22.

A detailed analysis of the claims follows.

Claim 1:

Cohn teaches a system for web-based virtual advertising (*Advertisements sent from a server to a client for display at the client are virtual advertisements.*), comprising:

a web server contained within a first computer (*The many different web pages the user views at his client computer are from computers different than the host server.*) and having a first vector graphics image (*Macromedia Flash is taught by this reference as a means to provide the images. Macromedia Flash is a scalable vector graphics file format for images.*) and a web page containing a link to the first image (*At column 7 line 13 this reference teaches the web page has links to other resources such as image, video and audio data. Macromedia Flash is taught by this reference as a means to provide the images.*);

an ad server contained within a second computer (*Cohn describes the sources of the advertisements as being other Internet computers at column 1 lines 54-60. At column 7 line 46 to column 8 line 12 the host server is described as providing the advertisements. This server is a different server from the many other different*

servers which provides to the user's client the user's requested web page.) and having a second vector graphics image (Column 9 lines 46-60 and column 11 lines 16-36 describes using Macromedia Flash to produce the advertisement images on the client's computer display.);

a client contained within a third computer (Browser device 10 is a computer. Refer to figures 1-3. At column 5 lines 27-31 Cohn explicitly state the browser device 10 may be a computer.) and adapted to receive the web page from the web server (The web page the user wishes to view (or is viewing) is from a web server.) and to receive the first and second images from the web server (The currently viewed web page is from the web server.) and the ad server (The advertisement is from a host server which is providing the services of an ad server. Also as indicated in this references background, different advertisements may be from respective ad servers.), respectively; and

an editor (The portion of the browser's program that overlays is considered at least to be an editor.) adapted to operate within the client for overlaying a portion of the first image with the second image, to produce a modified version of the first image (The advertisement is displayed on the client computer's display by merging a portion of the currently displayed image with the advertisement image. Refer to column 9

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lines 46-60 and column 11 lines 16-36 which describes using Macromedia Flash to produce the images on the client's computer display by using translucency. Translucency removes a portion of a first image and replaces it with a portion of a second image. Applicant's specification at page 15 lines 11-19 describes how database 78 specifies specific locations where the advertisement will be located in the web page's image, however, the broad scope of this claim covers much more than overlaying a specific location of the web page image with an ad of a specific size.).

Claim 2: Cohn teaches the system as recited in claim 1, wherein the first image, second image or both the first and second images are scalable vector graphic images (Macromedia Flash is scalable vector graphics, therefore, Cohn's bit map or Macromedia Flash web page image and the Macromedia Flash or bit map advertisement image are scalable vector graphic images.).

Claim 6:

Cohn teaches the system as recited in claim 1, wherein the first and second images are represented as first and second files containing instructions in a vector graphic programming language (The script used to develop Macromedia Flash files are files containing vector graphic instructions.).

Claim 8:

Cohn teaches the system as recited in claim 1, wherein the client operates a web browser (*Refer to column 6 lines 13-18.*) and is coupled via the Internet to the web server (*Any provider of the web pages.*) and the ad server (*At least the host server.*).

Claim 9:

Cohn teaches the system as recited in claim 1, further comprising a database in the ad server, such that the database associates the second image with the first image (*At column 10 lines 56-62 step 330 is described as having the host server select an advertisement according to an advertising management process. This process has clearly associated the advertisement image with the web page's image. This process clearly has an associated database for storing the selected association.*).

Claim 10:

Cohn teaches the system as recited in claim 9, wherein the database specifies the location and size of the portion of the first image to be overwritten by the second image (*Inherently the size of the advertisement is selected by the ad server as well as its location on the web page. In the translucency mode a portion of the first image will be overlayed by the advertisement when the advertisement image does not cover*

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a full web page. Applicant's specification at page 15 lines 11-19 has been considered.).

Claim 11:

Cohn teaches the system as recited in claim 10, wherein the location and size of the portion of the first image to be overwritten by the second image are determined by a computer program (*It is clear from figure 7 with reference to the rightmost display screen shot that shows advertisement 450 placed in a window. The size of the window and its location are controlled by the browser's computer program.).*

Claim 12: Cohn teaches the system as recited in claim 1, wherein the web server and ad server are computer program execution units (*Web servers and ad servers are embodied as computer programs which are computer program execution units.*) adapted to transmit, receive and process data stored in a carrier medium (*Internet network 96.*) adapted for transmission therebetween (*This term does not appear in any standard dictionary, both Websters and American Heritage were consulted, therefore its broadest meaning would be the transmission of data between a web server, Cohn's host server 98, and the advertisements sources.).*

Claim 13:

This claim is a method version claim of system claim 1. This claim is also broader than system claim 1. It does not claim the editor. Claim 13 is rejected for the reasons given for claim 1.

Claim 14:

This claim is a method version claim of system claim 2. Claim 14 is rejected for the reasons given for claim 2.

Claim 15:

This claim is a method version claim of system claim 6. Claim 15 is rejected for the reasons given for claim 6.

Claim 3:

This claim is similar to claim 1. The difference is the ad server sends the second vector graphics image to the web server and the editor is in the web server. The host server in Cohn is able to be a web server that sends a requested web page containing a first vector image to the client and modifies the first vector image by selecting the advertisement that will be merged into the first vector image. The selection program may be located in the web server, refer to column 7 lines 49-54.

Cohn teaches a system for web based virtual advertising comprising:

an ad server contained within a second computer (*Cohn describes the sources of the advertisements as being other Internet computers at column 1 lines 54-60. At column 7 line 46 to column 8 line 12 the host server is described as providing the advertisements.*

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Column 1 line 49 to column 2 line 3 and column 7 line 55 to column 8 line 7 describes selecting the advertisement that will be associated with a web page.) and having a second vector graphics image (Column 9 lines 46-60 and column 11 lines 16-36 describes using Macromedia Flash to produce the advertisement images on the client's computer display.);

a web server (The host server 98 may be considered a web server.) contained within a first computer and having a first vector graphics image (The host server 98 would likewise have a web page having links to images formed by Internet software such a Macromedia Flash as described above for claim 1.) and a web page containing a link to the first image wherein the web server is adapted to receive the second image from the ad server (As discussed previously the advertisements are sent to the host server for distribution to the client computers.);

an editor (Any program that edits or causes editing may be considered an editor.) adapted to operate within the web server to overlay a portion of the first image with the second image to produce a modified version of the first image (In the host server is software programs that associate advertisements to web pages, see column 1 line 49 to column 2 line 3 and column 7 line 55 to column 8 line 7, this program has effectively modified the first vector image by selecting the advertisement that will be merged into the first vector image.

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At column 7 lines 49-545 teaches to place the selection program at the web server, therefore the web server has modified the first vector graphics image, Macromedia Flash, with the advertisement's vector graphics image, also Macromedia Flash. The advertisement is displayed on the client computer's display by merging a portion of the currently displayed image with the advertisement image. Refer to column 9 lines 46-60 and column 11 lines 16-36 which describes using Macromedia Flash to produce the images on the client's computer display by using translucency. Translucency removes a portion of a first image and replaces it with a portion of a second image. Applicant's specification at page 15 lines 11-19 describes how database 78 specifies specific locations where the advertisement will be located in the web page's image, however, the broad scope of this claim covers much more than overlaying a specific location of the web page image with an ad of a specific size.); and

a client contained within a third computer and adapted to receive the web page and the modified version of the first image from the web server (Browser 10 receives the web page from the host server and the modified first vector image, modified by selecting the advertisement that will be merged by the client computer onto the first vector image.).

Claim 26:

Cohn teaches the system as recited in claim 3, further comprising a database in the ad server, such that the database associates the second image with the first image (*Refer to the discussion given for claim 9.*).

Claim 27:

Cohn teaches the system as recited in claim 26, wherein the database specifies the location and size of the portion of the first image to be overwritten by the second image (*Refer to the discussion given for claim 10.*).

Claim 28:

Cohn teaches the system as recited in claim 27, wherein the location and size of the portion of the first image to be overwritten by the second image are determined by a computer program (*Refer to the discussion given for claim 11.*).

Claim 4:

This claim is similar to claim 1. The difference is the ad server receives the first vector graphics image from the web server and the editor is in the ad server. The host server in Cohn functions as an ad server that is capable to receive web pages having first vector image and that modifies the first vector image by selecting the advertisement that will be merged into the first vector image.

A system for web based virtual advertising comprising:

a web server contained within a first computer and having a first vector graphics image and a web page containing a link to the first image (*See the discussion given for claim 1.*);

an ad server (*host server 98*) contained within a second computer and having a second vector image (*As discussed above the advertisements are describes as being Macromedia Flash.*), wherein the ad server is adapted to receive the first image from the web server (*The term adapted to is a broad term. Host server is adapted to receive the first vector graphics image, Macromedia Flash, from the web server.*);

an editor (*Any program that edits or causes editing may be considered an editor.*) adapted to operate within the ad server (*Host server 98.*) to overlay a portion of the first image with the second image to produce a modified version of the first image (*In the host server is software programs that associate advertisements to web pages, see column 1 line 49 to column 2 line 3 and column 7 line 55 to column 8 line 7, this program has effectively modified the first vector image by selecting the advertisement that will be merged into the first vector image.*

At column 7 lines 49-545 teaches to place the selection program at the ad server, therefore the ad server has modified the first vector graphics image, Macromedia Flash, with the advertisement's vector graphics image, also Macromedia Flash.

The advertisement is displayed on the client computer's display by merging a portion of the currently displayed image with the advertisement image. Refer to column 9 lines 46-60 and

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column 11 lines 16-36 which describes using Macromedia Flash to produce the images on the client's computer display by using translucency. Translucency removes a portion of a first image and replaces it with a portion of a second image. Applicant's specification at page 15 lines 11-19 describes how database 78 specifies specific locations where the advertisement will be located in the web page's image, however, the broad scope of this claim covers much more than overlaying a specific location of the web page image with an ad of a specific size.); and

a client contained within a third computer and adapted to receive the web page from the web server and the modified version of the first image from the ad server (Browser 10 receives the web page and the first vector image from the web server. Browser 10 receives from the ad server selected advertisements that modifies the first vector image. Thus, the first vector graphics image has been modified by the second vector graphics image by the ad server.).

Claims 29-31:

See the discussion of claims 26-28.

Allowable Subject Matter

7. Claim 7 and 16-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior of record fails to teach or suggest overlaying a portion of the first vector graphics image with the second vector graphics image by inserting instructions from the second file into the first file.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is 703-305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffery A Brier
Primary Examiner
Art Unit 2672